

III. REPLY TO REJECTION OF CLAIMS UNDER 35 USC § 102

A. Summary of the Rejection

Claims 1, 3, 5, 13, 17 and 19 have been rejected under 35 USC § 102(e) as anticipated by US Patent No. 5,838,364 ("the '364 patent") to Ishibe et al ("Ishibe '364").

B. Reply Re Claims 1, 3 and 5

In reply to the specific grounds asserted in the rejection of claims 1, 3 and 5 Applicants would point out that the Office Action has failed to establish a correspondence of each and every element of these claims to features found in Ishibe '364. Specifically, claims 1, 3 and 5 require the claimed scanner to have "a housing having a scanning surface thereon." The compact film player described in Ishibe '364 has no such structure.

As shown in Figures 1-4 the '364 patent teachings are limited to two embodiments; in one of which a cartridge is positioned in a cavity in the housing, and in the other of which a film slot 8 is provided in the side surface of the housing for permitting a strip of film to be fed through the slot. In neither of these embodiments does the housing have any "scanning surface."

In regard to the cartridge embodiment, no description is provided about the cartridge sufficient to determine whether it, in turn has a scanning surface. Thus, with respect to the cartridge embodiment it may be true that no scanning surface is provided in either the cartridge or the film player housing, and it is certainly true that no such scanning surface is provided by the housing itself.

In regard to the piece of film embodiment no other structure is provided as a scanning surface. Thus, it is the piece of film itself that is the scanning surface; not the housing that provides for a scanning surface as claimed.

Applicants note that at page 3 of the Office Action, the first full paragraph asserts that the '364 patent has a "supporting surface" allegedly shown in Figures 4(A) and 4(B), and that the "original supporting surface reads on the claimed scanning surface." However, to the extent that this statement is understood, Applicants believe that it is flawed through errors of fact, law and logic.

First, no specific structure in Ishibe '364 is identified as the "supporting surface." Thus, even if the Office Action allegations were legally relevant to the rejection made to claims 1, 3 and 5, Applicants have not been placed on factual notice of what the Patent Office considers to be a prior art structure that is necessary to meet a burden of establishing anticipation.

Second, even if some structure in Ishibe '364 is identified as a "supporting surface" no such "supporting" surface is claimed. Rather, it is a "scanning surface" that is claimed. As is readily apparent from the present application the several embodiments provide a glass platen 24 as support for the claimed "scanning surface" term. Thus, the scanning surface lies directly in the scan path of the CCD or CIS scanner. No such structure is described in Ishibe '364.

Third, application of the "read on" test is backward in the Office Action. Whether applied in the context of anticipation or obviousness, it is well settled that it claims that are to be "read on" prior art; not prior art read on claims. While it may be true that a scanning surface in a flatbed scanner provides support for the object to be scanned and thus a prior art "supporting surface" would "read on" a "scanning surface" claim term when the claim term related to a flatbed scanner, it does not follow that all "supporting surfaces" (particularly any undefined "surface" in the Ishibe film player) are necessarily a "scanning surface." Thus, the Office Action's reversal of the "read on" test is a logical error, and by itself requires withdrawal of the rejection.

For each and every one of the reasons stated above it is believed that the rejection to claims 1, 3 and 5 is in error and should be withdrawn.

C. Reply Re Claims 13, 17 and 19

In reply to the specific grounds asserted in the rejection of claims 13, 17 and 19 Applicants would point out that independent claim 13 has been amended to require that the claimed scanning method take place with a "stand alone flatbed" scanner. Support for this amendatory language is found at numerous places in the application as filed, for example, Figures 13-, 6-8, 10-16 and 20; page 1, lines 8 and 22-28; page 2, lines 23-28; page 3, line 9-11; and page 6, lines 17-22.

In regard to claims 13, 17 and 19, as presently amended Applicants emphasize that Ishibe '364 is directed to a compact film player. It is not a stand alone flatbed scanner. Also, as explained above in detail regarding claims 1, 3 and 5, the film player of Ishibe '364 has neither structure nor operational capability necessary to be a stand alone flatbed scanner and/or to be capable of operating as does a stand alone flat bed scanner.

It is also noted that the "read on" test has been incorrectly applied in the Office Action in that numerous prior art structures are asserted to anticipate the claims because these structures "read on" the claimed structures. However, as is well settled the test is properly applied only when, as a matter of fact the claims are properly "read on" to prior art structures or processes.

For all of the above reasons a rejection of claims 13, 17 and 19 under 35 U.S.C. § 102 is not and could not be established under present law. It is therefore respectfully requested that this rejection be withdrawn.

IV. REPLY TO REJECTION OF CLAIMS 4, 14 and 15 UNDER 35 USC § 103

A. Summary of the Rejection

Claims 4, 14 and 15 have been rejected under 35 USC § 103(a) as unpatentable over Ishibe '364 and US Patent No. 5,754,713 ("the '713 patent") to Deguchi et al ("Deguchi '713). In this regard the Office Action admits that the film reader of the Ishibe '364 patent "does not disclose a removable data storage medium as claimed."

B. Reply Re Claims 4, 14 and 15

Before addressing the merits of the obviousness issue presented in the rejection, Applicants emphasize that claim 4 depends from claim 1 and claims 14 and 15 depend from claim 13. These claims have been rejected as anticipated, and Applicants have replied to those rejections in the paragraphs above. Those replies are equally applicable to the obviousness type rejections made under § 103, and are incorporated herein as if fully set forth.

Deguchi describes an image reading device that has a bottom side 2 having a "reading use window" and a top side having a "confirming use window" 3 and a "display" 4. This device is used to "simplify and shorten the scrapbook-making job for newspaper articles." (column 10, lines 58-60). The device is placed on a newspaper page with the window 2 facing down and the window 4 and display 4 facing up to the user. (e.g., column 2, lines 48-60) The user is then able to view the part of the newspaper that will be scanned, and is able to adjust the position of the device so that it scans the desired newspaper article.

In reply to the grounds asserted in the rejection and specific to claims 4, 14 and 15, Applicants would point out that the Office Action has failed to establish *prima facie*

obviousness. In order to establish *prima facie* obviousness, a suggestion, motivation or teaching to make the claimed combination must be found in the cited prior art. Here there is none.

First, as discussed above, the Ishibe '364 device is not a stand alone flatbed scanner and does not have a scanning surface as claimed. As is readily apparent from the figures and written description of the '713 patent its image-reading device is not a stand alone flatbed scanner, and it does not have a scanning surface as claimed. Thus, even if some motivation existed to modify the Ishibe '364 film reader to incorporate a removable storage medium, as suggested in the Office Action, the result would not be a scanner as claimed. It simply is not possible to combine the teachings of two devices that are not stand alone flatbed scanners and do not have a scanning surface and have the resulting combination be a stand alone flatbed scanner that does have such a scanning surface. For this reason alone the rejection should be withdrawn.

Assuming *arguendo* that a combination of the teachings of the two references would result in a flatbed scanner, nevertheless there is no suggestion, motivation or other reason in either of the references to the effect that they should or could be combined. To the contrary, the references themselves teach away from such a combination. The Ishibe '364 film reader is for rapid reproducing of one frame of a film after the other, has a CPU 40 for processing the digital signals that result from the scanning of successive frames of the film and send the processed images to a television. The main objective of Ishibe is to have the capability of rapidly reproducing each subsequent frame on the film. Thus, "external" processing is not necessary because it would duplicate the processing capability already incorporated into the Ishibe device and "external" output would necessarily be undesirable because it would consume precious time needed by the system to reproduce each subsequent frame on the film and would otherwise appear to simply be a basis for duplicating the processing that already takes place in the Ishibe

'364 system. Thus, the teachings of Ishibe actually teach away from the combination proposed in the Office Action. The teachings of Deguchi '713 further expose the proposed combination to be the result of a hindsight analysis. Whereas Ishibe is directed to frames of film that are reproduced and displayed on a television, Deguchi is directed to making scrapbooks from newspaper articles. These are very disparate fields of invention, and there is no teaching in Deguchi to the effect that any improvement to the television images of frames of film would result if an external memory for newspaper clippings was used to replace the internal memory already found in Ishibe.

For the reasons discussed above it is apparent that the rejection is based on a hindsight analysis, and therefore should be withdrawn.

V. REPLY TO REJECTION OF CLAIMS 6-10, 12, 16 AND 18 UNDER 35 USC § 103

A. Summary of the Rejection

Claims 6-10, 12, 16 and 18 have been rejected under 35 USC § 103(a) as unpatentable over Ishibe '364 and US Patent No. 5,631,745 ("the '745 patent") to Wong et al ("Wong '745"). Independent claim 6 and its dependent claims 7-10 and 12 are directed to a scanner projection system. Dependent claims 16 and 18 depend from independent claim 13 and are directed to a method of displaying a scanned image.

The Office Action admits that in Ishibe '364 the scanner and CPU are integrated in the film player instead of being stand alone devices as claimed, and points out that Wong '745 does have a stand alone CPU. The Office Action alleges that it would have been obvious to combine these teachings to yield the claimed invention for the purpose of avoiding "the need to communicate with a host processor as suggested by Wong"

B. Reply Re Claims 6-10 and 12

In reply to the specific grounds asserted in the rejection of claims 6-10 and 12 Applicants would point out that the Office Action has failed to establish *prima facie* obviousness. In order to establish *prima facie* obviousness, a suggestion, motivation or teaching to make the claimed combination must be found in the cited prior art. Here there is none. Rather, the references actually teach away from the claimed combination.

Assuming *arguendo* that a combination of the teachings of the two references would result in a system as claimed there is no suggestion, motivation or other reason in either of the references to the effect that they should or could be combined. To the contrary, the references themselves teach away from such a combination. In essence both references use a CPU, for a total of two CPU's, and the Office Action proposes combining the references in a manner that would eliminate one of the CPU's – the CPU in Ishibe. However, due to the specific purpose of the Ishibe '364 film reader, its CPU should remain integral. Thus, Ishibe directly teaches away from the claimed combination.

Specifically, the Ishibe '364 film reader is for rapid reproducing of one frame of a film after the other. Its CPU 40 is for processing the digital signals that result from the scanning of successive frames of the film and then for sending the processed images to a television. The main objective of Ishibe is to have the capability of rapidly reproducing each subsequent frame on the film. Thus, "external" processing is not necessary because it would duplicate the processing capability already incorporated into the Ishibe device. Also, "external" output would necessarily be undesirable because it would consume precious time needed by the system to reproduce each subsequent frame on the film. Finally, any external or stand alone CPU would otherwise appear to simply be a basis for duplicating the processing that already takes place in

the Ishibe '364 system. Thus, the teachings of Ishibe actually teach away from the combination proposed in the Office Action.

The teachings of Wong '745 further expose the proposed combination to be the result of a hindsight analysis. Whereas Ishibe is directed to frames of film that are reproduced and displayed on a television, Wong '745 is a telecommunications instrument that "is a stand-alone voice and fax messaging unit." (column 1, lines 51-54. The only mention of a scanner is merely one item mentioned in a listing at column 3, lines 50-53 of several devices that may be connected to the inventive voice and fax instrument. No other information is provided re such a scanner. These are very disparate fields of invention, and there is no teaching in Ishibe that would suggest it would be useful in voice and fax messaging. Rather, it appears that Ishibe is limited to the field of film editing, and in this context it is of paramount importance to have rapid reproduction of each subsequent frame of the film. Thus, there is no teaching in Wong '745 to the effect that any improvement to the television images of frames of film would result if an external memory for voice and fax messaging was used to replace the internal memory already found in Ishibe.

For the reasons discussed above it is apparent that the rejection is based on a hindsight analysis, and therefore should be withdrawn.

C. Reply Re Claims 16 and 18

In reply to the specific grounds of rejection asserted against claims 16 and 18 Applicants emphasize that these claims depend from method claim 13, and that parent claim 13 has been rejected above under 35 U.S.C. § 102. Because claims 16 and 18 depend from amended claim 13 Applicants also incorporate by reference as if set forth in full herein their reply to the rejection of claim 13 set forth above. For these reasons this rejection should be withdrawn.

VI. REPLY TO REJECTION OF CLAIMS 2 AND 20 UNDER 35 USC § 103

A. Summary of the Rejection

Claims 2 and 20 have been rejected under 35 USC § 103(a) as unpatentable over Ishibe '364 and "well known art."

The Office Action admits that Ishibe '364 fails to disclose an LCD projector.

B. Reply Re Claims 2 and 20

In reply to the specific grounds of rejection asserted against claims 2 and 20 Applicants emphasize that these claims depend from parent claims 1 and 13, that parent claims 1 and 13 have been rejected above under 35 U.S.C. § 102 and that the replies to those rejections apply equally here. Because claims 2 and 20 depend from claims 1 and 13 Applicants also incorporate by reference as if set forth in full herein their reply to the rejections of claims 1 and 13 set forth above. For these reasons alone, the rejections should be withdrawn.

In further reply to the specific grounds asserted in the rejection of claims 2 and 20, Applicants would point out that the Office Action has failed to establish *prima facie* obviousness for another reason. In order to establish *prima facie* obviousness, there must be a secondary reference that describes the claim elements that are missing from the primary reference, and a suggestion, motivation or teaching to make the claimed combination, which suggest must also be found in the cited prior art. In the rejection here made to claims 2 and 20 there is no secondary reference, and thus there necessarily is no suggestion for a combination. Thus, the rejection should be withdrawn for these reasons alone.

VII. REPLY TO REJECTION OF CLAIM 11 UNDER 35 USC § 103

A. Summary of the Rejection

Claim 11 has been rejected under 35 USC § 103(a) as unpatentable over Ishibe '364 and Wong '745 patent in view of "well known art." Claim 11 depends from independent claim 6, which is directed to a scanner projection system.

The Office Action admits that Ishibe '364 and Wong '745 fail to disclose an LCD projector.

B. Reply Re Claim 11

In reply to the specific grounds of rejection asserted against claim 11 Applicants emphasize that this claim depends from parent claim 6, that parent claim 6 has been rejected above under 35 U.S.C. § 103 and that the reply to that rejection applies equally here. Because claim 11 also depends from claim 6 Applicants also incorporate by reference as if set forth in full herein their reply to the rejection of claim 6 set forth above. For these reasons alone, the rejections should be withdrawn.

In further reply to the specific grounds asserted in the rejection of claim 11, Applicants would point out that the Office Action has failed to establish *prima facie* obviousness for another reason. In order to establish *prima facie* obviousness, there must be a secondary reference that describes the claim elements that are missing from the primary reference, and a suggestion, motivation or teaching to make the claimed combination, which suggest must also be found in the cited prior art. In the rejection here made to claim 6 there is no secondary reference, and thus there necessarily is no suggestion for a combination. Thus, the rejection should be withdrawn for these reasons alone.

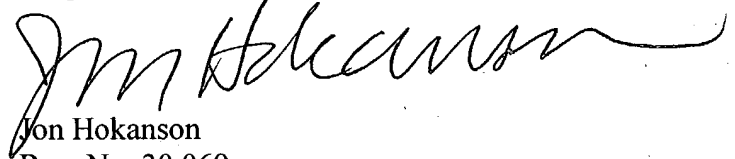
VIII. CONCLUSION

For all of the above reasons, it is believed that the above-identified patent application is now in condition for allowance.

The Commissioner is authorized during the prosecution of this application to charge fees that may be required or credit any overpayment of fees to Deposit Account No. 501215, except for payment of patent issue fees required under 37 CFR § 1.18. Please show our above-referenced number with any credit or charge to our Deposit Account.

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